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WENDEROTH LIND & PONACK
2033 "K" STREET N W
SUITE 800
WASHINGTON, DC 20006

EXAMINER

O'CONNOR, GERALD J

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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20060928

Application Number: 09/436,656
Filing Date: November 9, 1999
Appellant(s): Tagawa et al.

Kenneth W. Fields
(Reg. No. 52,430)
For Appellant

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed June 2, 2006.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(Assignee of record, *Matsushita Electric Industrial Co., Ltd.*)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1-21, 25, and 29-42 have been cancelled.)

(Claims 22-24, 26-28, and 43-48 are pending, rejected, and appealed.)

(Claims 49-54 remain pending, but stand withdrawn from further consideration.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. (No after-final amendments have been filed.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 22-24, 26-28, and 43-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Imai et al. (US 5,870,467).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

5,870,467	Imai et al.	2/1999
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(9) *Grounds of Rejection*

Claims 22-24, 26-28, and 43-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Imai et al. (US 5,870,467). Note that, in making this rejection, the extensively recited functional language has been deemed merely intended usage of the invention, hence,

afforded little patentable weight, as the apparatus of Imai et al. is inherently capable of performing the recited functions. See MPEP §§ 2114 and 2173.05(g).

Imai et al. show a data conversion apparatus 100 comprising: a data transmission/receiving section/means 11; a data format judging section/means 3; an attribute information obtaining section/means 4; a user ID storage section/means storing identification information identifying the user of the data conversion apparatus (a user ID identifying the user of the data conversion apparatus being necessarily, thus inherently, present in order to perform the disclosed “authentication”); a ciphering section/means 132 for ciphering the attribute information (ciphering being necessarily, thus inherently, present in order to “protect” the data in the manner disclosed); a data format conversion section/means 5 for adding the ciphered attribute information and identification information to the audio contents; and, a controller 1, wherein the data transmission/receiving section/means of Imai et al. includes a data read-out portion 6 and a network interface 102. See, in particular, Figure 11.

Regarding claims 23 and 44, the data conversion apparatus of Imai et al. further comprises a data outputting section/means 6.

Regarding claims 24 and 45, the data conversion apparatus of Imai et al. further comprises a recording section/means 105 and a charging section 104.

Regarding claims 26-28 and 46-48, the recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight, as the apparatus of Imai et al. is inherently capable of performing the recited functions. See MPEP §2114.

(10) Response to Argument

I. Claims 22-24, 26-28, and 43-48 are unpatentable under 35 U.S.C. 102(e) for being anticipated by Imai et al. (US 5,870,467).

As an initial matter, the examiner notes that appellant's claims are structured to merely recite various generic elements of hardware/apparatus in combination with extensive functional language setting forth the manner in which the apparatus is intended to be employed. While there is nothing inherently improper in defining something by what it *does*, rather than by what it *is*, such functional recitations do not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus includes all the structural limitations of the claim. The functional language is considered merely the intended use for the claimed apparatus, and a recitation of the intended use of the claimed apparatus must result in a *structural* difference between the *claimed* invention and the prior art in order to *patentably distinguish* the claimed invention from the prior art. The same intended use need neither be disclosed in, nor inherently performed by, the prior art. As long as the prior art structure is *capable* of performing the intended use, then it meets the claim.¹

Furthermore, as recited in the preamble of each of appellant's independent claims 22 and 43, the purpose of appellant's claimed apparatus is, "for use in converting data including audio contents to superdistribution format data and outputting the superdistribution format data to be supplied to [an] external recording apparatus to be recorded therein." Note that appellant did not invent the "superdistribution" concept. "Superdistribution" is a particular system of digital rights

¹ *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

management. As explained by Mori et al. in the attached article, *Superdistribution: The Concept and the Architecture*, published in 1990, “The concept was invented by Mori in 1983.”² See, in particular, col. 1, lines 34 and 35. Additionally, the Mori et al. article goes on to clearly explain the full meaning of the term, “Superdistribution,” recited by the claims and used in the applied prior art reference, Imai et al. Importantly, note that all of the extensive functionality recited by appellant, and the apparatus to implement it, is inherent to the superdistribution concept/system, as defined/invented by Mori. Appellant has therefore invented no new functionality at all, nor by extension, any new apparatus necessary to perform that known functionality, hence, appellant has failed to provide any progress or advancement in the state of the art.

The Patent Clause of the Constitution, Article I, §8, cl. 8, gives Congress the power to authorize the issuance of patents “[t]o promote the Progress of Science and the useful Arts,” but “[t]he Patent Clause itself reflects a balance between the need to encourage innovation and the avoidance of monopolies which stifle competition without any concomitant advance in the ‘Progress of Science and the useful Arts.’ ”³ Congress may not “authorize patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available.”⁴ Here, appellant seeks exactly that, to be granted a patent monopoly merely for

² Mori, R. et al., “Superdistribution: The Concept and the Architecture,” pp. 1133-1146, 1990, The Transactions of the IEICE, Vol. E 73, No. 7, Tokyo, JP (Copy attached).

³ *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 9 USPQ2d 1847, 1850 (U.S. Sup. Ct. 1989).

⁴ *Graham v. John Deere Co. of Kansas City*, 148 USPQ 459, 462 (U.S. Sup. Ct. 1966).

generic apparatus that broadly implements/ embodies the invention/system of another, foreclosing all others from that invention/system, even precluding the actual inventor of that system from being able to practice/use his own invention. Clearly, such a patent grant would be improper, unjust, and against the public interest that the patent system is dedicated and envisaged to serve.

Claim Group A (Claims 22 and 26-28):

Regarding the argument that functional language must be considered (i.e., not ignored), and that the examiner has simply ignored applicant's functional language, functional language must indeed be considered, and the entirety of applicant's functional language has, in fact, been duly considered, and *no* recitations, functional or otherwise, have been *ignored*.

Regarding the arguments *vis-à-vis* inherency, appellant seems to be confused between the concept of the prior art *inherently performing* the recited functionality (appeal brief, page 9, lines 20 and 21), versus the concept of the prior art being *inherently capable of performing* the recited functionality (appeal brief, page 9, lines 18 and 19). All that is required for anticipation is that the prior art be *inherently capable* of performing the claimed functionality, and it is the finding of the examiner, as trier-of-fact, that here, the applied prior art is indeed *inherently capable of performing* all of the recited/claimed functionality, *not* necessarily that all of the recited/claimed functionality is *inherently* (i.e., necessarily) performed.

Feature 1 (The “Data Format Judging Section”):

Regarding the argument that the references applied in the rejection fail to use the same names for certain elements as the names used by applicant (e.g., the non-functional descriptive material being labeled/called “superdistribution,” as opposed to some other name/description), it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but need not be in the identical words as used in the claims in order to be anticipatory.⁵ Additionally, it is also well settled that expressions relating a claimed *apparatus* to the *contents thereof* during an intended operation are of *no significance* in determining patentability of the apparatus claim,⁶ and that the inclusion of material or article worked upon by a structure being claimed *does not impart patentability to the claims*.⁷

In this case, as acknowledged by appellant, the apparatus of Imai et al. indeed judges whether or not the data is protected, in the same manner as claimed by appellant. Imai et al. simply having decided to call their protected data by a name other than “superdistribution format data,” without any actual difference in any of the structure of the device or its manner of operation on the named thing/data, is simply insufficient to patentably distinguish another device over the prior art device. For example, claiming “a car for driving down a road” would be insufficient to patentably distinguish the *car* over a prior art reference disclosing only “a car for driving down a street.”

⁵ *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

⁶ *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

⁷ *In re Young*, 25 USPQ 69 (CCPA 1935), as restated in *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Feature 2 (The “Attribute Information Obtaining Section”):

Regarding the argument that the attribute information obtaining section/means 4 of Imai et al. is incapable of performing the functionally recited intended use of, “identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section,” the attribute information obtaining section/means 4 of Imai et al. indeed performs the steps of “identifying” (*Ascertaining the origin, nature, or definitive characteristics of*)⁸ the audio contents of the data (since the device *necessarily* ascertains/determines the nature of the data, that the data is digital data in a recognizable, coherent, useable format, as opposed to random background noise) and “obtaining” attribute information (e.g., the ID of the file/dataset, etc.) corresponding to the identified audio contents (the file/dataset) from the external equipment via a data transmission/ receiving section (obviously the device *necessarily* sends and receives data, thus, is inherently capable of transmitting and receiving data via a data transmission/receiving section).

To the extent that appellant is arguing that Imai et al. fail to disclose certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., performing a CDDB.com-type of remote audio CD database lookup to identify a normal, non-super-distribution, audio CD) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.⁹

⁸ *The American Heritage Dictionary of the English Language, Third Edition*, Houghton Mifflin Co., 1992.

⁹ *In re Van Geuns*, 988 F.2d 1181; 26 USPQ2d 1057 (Fed. Cir. 1993).

Feature 3 (The “User ID Storage Section”):

Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of storing identification information identifying the user of the data conversion apparatus, the data conversion apparatus 100 of Imai et al. is indeed capable of storing identification information identifying the user of the data conversion apparatus, since a user ID identifying the user of the data conversion apparatus is necessarily, thus inherently, present in order to perform the disclosed “authentication” (authentication being the determination/establishment of identity).

Regarding the argument that the apparatus of Imai et al. authenticates a program 106, not the user, therefore, does not comprise a user ID storage section storing identification information of the user of the data conversion apparatus, the program 106 is being used by the user, therefore, the identification/authentication information of the program is the identification information of the user. The two are uniquely and inseparably associated and logically attached. Therefore, the apparatus of Imai et al. indeed includes a user ID storage section storing identification information of the user, as broadly claimed by applicant. Note that the claim does not require, for example, the actual given name of the individual operating the system, but reads merely on storing any information that serves to identify that user. Again, because the claim is so broad, the information need not even be unique. Regarding the term “user-ID” specifically, note that the term merely requires any general “ID” (identification)

information regarding the “user,” nothing more. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.¹⁰

Feature 4 (The “Ciphering Section”):

Regarding the argument that the ciphering section 132 of Imai et al. does not encipher the attribute information and identification information, the ciphering section 132 of Imai et al. indeed enciphers the attribute information and identification information, or it could not accomplish the tasks that it performs. See, for example, columns 9 and 10, and columns 19 and 20. In other words, if the data were not enciphered, it would not be protected, and protecting the protected data is the express point of the entire system of Imai et al.

Feature 5 (The “Data Format Conversion Section”):

Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of reading data out of a disc medium, the data conversion apparatus 100 of Imai et al. is indeed capable of reading data out of a disc medium, and the examiner specifically notes that audio contents of a CD are considered “data in a disc medium.”

Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of recording superdistribution format data, the data conversion apparatus 100 of Imai et al. is indeed capable of recording superdistribution format data, as that is one of its explicitly

¹⁰ *In re Van Geuns*, 988 F.2d 1181; 26 USPQ2d 1057 (Fed. Cir. 1993).

disclosed intended purposes. Moreover, again, as noted above, it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory.¹¹

Feature 6 (The Optional Functional Language Regarding the “Controller”):

Regarding the argument that the attribute information obtaining section/means 4 of Imai et al. is incapable of performing the functionally recited intended use of, “identifying the audio contents of the data and obtaining attribute information corresponding to the identified audio contents from the external equipment via a data transmission/receiving section,” the attribute information obtaining section/means 4 of Imai et al. indeed performs the steps of “identifying” (*Ascertaining the origin, nature, or definitive characteristics of*)¹² the audio contents of the data (since the device *necessarily* ascertains/determines the nature of the data, that the data is digital data in a recognizable, coherent, useable format, as opposed to random background noise) and “obtaining” attribute information (e.g., the ID of the file/dataset, etc.) corresponding to the identified audio contents (the file/dataset) from the external equipment via a data transmission/receiving section (obviously the device *necessarily* sends and receives data, thus, is inherently capable of transmitting and receiving data via a data transmission/receiving section).

¹¹ *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

¹² *The American Heritage Dictionary of the English Language, Third Edition*, Houghton Mifflin Co., 1992.

To the extent that appellant is arguing that Imai et al. fail to disclose certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., performing a CDDDB.com-type of remote audio CD database lookup to identify a normal, non-super-distribution, audio CD) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.¹³

Claim Group B (Claim 23):

Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of recording superdistribution format data, the data conversion apparatus 100 of Imai et al. is indeed capable of recording superdistribution format data, as that is one of its explicitly disclosed intended purposes. Moreover, again, as noted above, it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory.¹⁴

Again, all of appellant's recited functionality is inherent to the industry-standard concept/system of superdistribution, none of which was invented or developed by appellant.

¹³ *In re Van Geuns*, 988 F.2d 1181; 26 USPQ2d 1057 (Fed. Cir. 1993).

¹⁴ *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim Group C (Claim 24):

Regarding the argument that Imai et al. does not disclose all of the recited functional language recited by applicant's apparatus claims relative to the specific copyright/data protection scheme/format known as "superdistribution" (though "superdistribution" is specifically mentioned by Imai et al.) a recitation of the intended use of the claimed invention must result in a *structural* difference between the *claimed* invention and the prior art in order to patentably distinguish the claimed invention from the prior art. As long as the prior art structure is *capable* of performing the intended use, then it meets the claim.¹⁵

Claim Group D (Claims 43 and 46-48):

Regarding the argument that all functional language must be considered in claims 43-48 because the claims are written in means-plus-function format, MPEP § 2181 states, in part, that "[a] claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for " or "step for ";
- (B) the "means for " or "step for " must be modified by functional language; and
- (C) the phrase "means for " or "step for " must not be modified by sufficient structure, material or acts for achieving the specified function."

¹⁵ *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claims 43-48 clearly satisfy the first and second of these three tests, since it has been held that a phrase such as “ink delivery means” is equivalent to the phrase “means for ink delivery.”¹⁶

However, it is not at all clear that appellant’s claims meet the third test, since each of the “means” is indeed “modified by sufficient, material or acts for achieving the specified function.”

In any event, assuming for the sake of argument that claims 43-48 do indeed meet all three tests required for 35 U.S.C. 112, sixth paragraph, the claims then clearly define *structure* in means-plus-function format, but, additionally, still recite *intended usage* as well, and the intended usage still need not be explicitly disclosed in the reference if the claimed *structure*, as disclosed in the reference, is inherently *capable* of performing the claimed *usage*.

For example, the recitation, “a ciphering means for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means” (claim 43, lines 18-19) includes both structure defined in means-plus-function language, “a ciphering means” (which recitation is considered equivalent to the more literal/traditional, “a means for ciphering,” as explained in MPEP § 2181, the “function” of the structure being “ciphering”) as well as an intended usage of the “means for ciphering,” that being, “for ciphering the attribute information obtained from the external equipment and the identification information stored in said user ID storage means.”

Note that, even if defined in means-plus-function format, apparatus claim limitations are still drawn to *structure*, and the structure in a reference, to be anticipatory, can *either* be

¹⁶ *Signtech USA, Ltd. v. Vutek, Inc.*, 50 USPQ2d 1372, 1374-75 (Fed. Cir. 1999).

the same as, *or equivalent to*, the disclosed structure of the claimed invention. See MPEP § 2114, which states, in part, “that means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification.”

Claim Group E (Claim 44):

Regarding the argument that functional language can necessitate structure in apparatus claims, functional language can indeed necessitate structure, but the claim would read on *any equivalent* structure of the prior art capable of performing the recited functions, no matter how different that “equivalent” structure might be from the *disclosed* invention/structure of applicant.

Regarding the argument that the data conversion apparatus 100 of Imai et al. is incapable of recording superdistribution format data, the data conversion apparatus 100 of Imai et al. is indeed capable of recording superdistribution format data, as that is one of its explicitly disclosed intended purposes. Moreover, again, as noted above, it is well settled that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory.¹⁷

Again, all of appellant’s recited functionality is inherent to the industry-standard concept/system of superdistribution, none of which was invented or developed by appellant.

¹⁷ *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim Group F (Claim 45):

Regarding the argument that inherent characteristics must necessarily be present, and that a mere possibility of presence is insufficient, applicant is correct, but with functional language, it is the *capability* to perform the recited function that must be necessarily present, not the *function* itself. The function need not be *performed* in order to be *capable* of being performed. Again, as long as the prior art structure is *capable* of performing the intended use, then it meets the claim.¹⁸

Once again, all of appellant's recited functionality is generically inherent to the industry-standard concept/system of superdistribution, indeed, even to the overall generic concept of digital rights management (DRM), for example users being charged for software, etcetera.


(11) Related Proceeding(s) Appendix

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

¹⁸ *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

For all of the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




9/28/06

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627

GJOC

September 28, 2006

Appeal Conference Held:


Alex Kalinowski
Supervisory Patent Examiner
Group Art Unit 3627
Sam Sough
Supervisory Patent Examiner
Appeal Conference Specialist
Technology Center 3600

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Copy to Appellant:

Wenderoth, Lind, & Ponack
2033 K Street, NW, Suite 800
Washington, DC 20006